

### **REMARKS**

The Final Office Action of April 6, 2006, has been considered by the Applicants. Claims 1 and 20 have been amended. Claims 1-3, 6-18, 20-27, 30, and 31 remain pending. Reconsideration of the Application is requested.

Claims 1-3, 6-18, 20-27, and 31 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants traverse the rejection.

The claims require a first and second charge transport layer, wherein the second charge transport layer contains hindered phenol, but the first layer does not. The Examiner stated that ¶¶ [0006] and [0014] were silent as to whether the hindered phenol was excluded from the charge transport layer.

Applicants submit that the Examiner is requiring this limitation to be described literally when such description is not needed to satisfy the written description requirement. MPEP § 2163.02. Furthermore, Examples II-IV show the inventors contemplated such a limitation. In these Examples, the first charge transport layer, which is 50 wt% polymer and 50 wt% diamine, excludes any antioxidant. If the rejection is merely due to the phrasing, Applicants have amended the claims to use the transitional phrase "consists of". This wording is supported by the specification, especially the Examples, and is not a negative limitation.

The Examiner also stated that claim 17 did not have basis because there was no disclosure of each of the first and second charge transport layers having independent thicknesses of about 10 to about 50  $\mu\text{m}$ . The specification makes this disclosure in ¶ [0014] at the top of page 8, beginning with the sentence, "Each of the dried charge transport layers..."

Applicants request withdrawal of the § 112, ¶ 1 rejections.

Claims 20-22 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicants traverse the rejection.

The Examiner stated it was unclear which of the two charge transport layers had the specified aryl amine molecules. Applicants have amended claim 20 to state

that both the first and second charge transport layers may have an aryl amine. Applicants also note that these claims do not require the two charge transport layers to have the same aryl amine. Basis for this amendment can be found in ¶ [0014] near the bottom of page 7.

Applicants request withdrawal of the § 112, ¶ 2 rejection.

Claims 1-3, 6-9, 14-18, 20, 24, 25, 27, and 31 were rejected under 35 U.S.C. 103(a) as obvious over Tokutake (2003/0087171), Mori (5,567,557), and Diamond.

Claims 1-3, 6-18, 20-27, 30, and 31 were rejected under 35 U.S.C. 103(a) as obvious over Tokutake, Mori, and Yuh (6,261,729).

Applicants traverse the rejections together.

The Examiner stated that Tokutake prefers the use of an antioxidant in the first charge transport layer, but not does require an antioxidant, and points to document claim 1. Applicants agree that claim 1 does not specifically recite antioxidants. However, claim 1 is an open-ended claim and can comprise such antioxidants. Furthermore, when antioxidants are recited, they are required in both the first and second charge transport layers. See document claims 4 and 18. Examples 1-5 all contain antioxidant in both charge transport layers as well. Applicants submit that Tokutake does not suggest the desirability of making an imaging member with antioxidant in only the second charge transport layer. Mori and Yuh only contemplate a single charge transport layer, so cannot suggest this limitation either. That the references can be combined does not render the combination obvious unless there is such a suggestion of desirability. MPEP § 2143.01(III).

For this reason, Applicants request withdrawal of the 103(a) rejections.

**CONCLUSION**

Applicants submit the pending claims (1-3, 6-18, 20-27, 30, and 31) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,  
FAY, SHARPE, FAGAN,  
MINNICH & McKEE LLP



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Richard M. Klein (Reg. No. 33,000)  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, OH 44114-2579  
(216) 861-5582